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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,298	12/22/2008	George Theodoridis	60329-USA	7066

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

SHTERENGARTS, SAMANTHA L

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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06/22/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,298	Applicant(s) THEODORIDIS ET AL.
	Examiner Samantha Shterengarts	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-11, 17-20, 31, and 37-40 is/are allowed.
- 6) ☒ Claim(s) 1,6 and 21-30 is/are rejected.
- 7) ☒ Claim(s) 2-5, 12-16 and 32-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>27 June 08</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____ |
|---|--|

DETAILED ACTION

Priority

1. The instant application is a national stage entry of PCT/US04/32730, which claims priority to U.S. Provisional application no. 60/510,568, and 60/609,533, filed October 10, 2003 and September 13, 2004.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 27, 2008 in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS document was considered. A signed copy of form 1449 is enclosed herewith.

Election/Restrictions

3. Applicant's election without traverse of the elected compound of claim 10 in the reply filed on April 4, 2011 is acknowledged.

Status of the Claims

4. Currently, Claims 1-40 are pending in the instant application.

Note: In Applicant's response, 4 April 2011, it was noted that all claims read on the species of claim 10; however, this is not the case. In claim 10, the N=O limitation on the piperidine of the compound is not in all of the other claims because, in claim 1 for example, Or—R_{6q}, cannot be N=O because R₆ cannot be an oxo substituent, even if r is zero. Also, the bond from the piperidine ring to the O atom is not a dotted line or something otherwise indicating that it can be a single or double bond, even if r and q are zero. Therefore, the elected species is not encompassed by all claims.

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5. The search has been extended to the full scope of compounds and all claims 1-40 are examined in their full scope.

Claim Objections

6. Claims 2-5, 12-16, and 32-36 are objected to for depending on a rejected base claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the limitation "further comprising one or more second compounds."

This phrase renders the claim indefinite because Examiner cannot determine the metes and bounds of the 'second compounds' as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

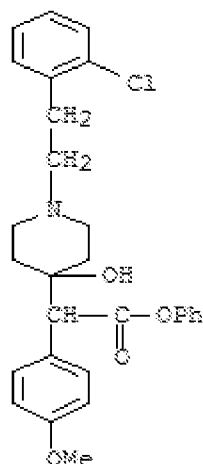
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 4,248,877.

U.S. Patent No. 4,248,877 teaches the following compound which anticipates claims 1 and 6:

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Wherein t and u are 1, p is zero, r and q are zero, A is ethylene, R7 is Cl and R8-R11 are H, X is hydroxyl, Y is H, R3 is -OMe and R1, R2, R4, and R5 are H, m is zero, and R is alkyl substituted with oxo and -OPh.

Allowable Subject Matter

9. Claims 7-11, 17-20, 31, and 37-40 are allowed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samantha L. Shterengarts/
Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626